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Docket: P/77-2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Eric Polesuk

Examiner: R. Doan

Serial No.: 10/072,528

Group Art Unit: 3732

Filed: February 8, 2002

Dated: February 9, 2009

For: READY-TO USE HAIRCOLORING FOIL

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

**APPEAL BRIEF**

Sir:

This is an Appeal from the decision dated July 8, 2008 of the Primary  
Examiner, finally rejecting the claims 9 and 10.

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**I. Real Party in Interest**

The real party in interest is Product Club Corp, located at 41 Pine Street,  
Unit 15, Rockaway, NJ 07866.

## **II. Related Appeals and Interferences**

There are no appeals or interferences related to the present application.

### **III. Status of Claims**

Claims 9 and 10 are on appeal.

Claims:

1. Cancelled
2. Cancelled
3. Cancelled
4. Cancelled
5. Cancelled
6. Cancelled
7. Cancelled
8. Cancelled
9. Rejected (Appealed)
10. Rejected (Appealed)

#### **IV. Status of Amendments**

There has been no amendments filed subsequent to the final rejection.

## **V. Summary of claimed subject matter**

The invention relates to a method of putting hair foil in a person's hair consisting of: removing a first sheet of hair foil from a pop-up dispenser. Pg. 7, lines 16-17. The first sheet of hair foil ranges in width from about 3.5 to 6 inches. pg. 6, lines 7-8, 15-16, pg. 7, line 28. The sheet of hair foil has a lead portion and a trailing portion. The lead portion of the sheet of hair foil extends through a dispensing orifice to an elevation above that of the dispensing unit. The trailing portion of the first hair foil sheet overlaps with a lead portion of a next hair foil sheet to be dispensed. The next hair foil sheet is pulled through the orifice of the dispenser by withdrawing the first sheet of hair foil. pg. 7, lines 17-22, pg. 8, lines 15-21, 23-24. The next hair foil sheets ranges in width from about 3.5 to 6 inches. pg. 6, lines 7-8, 15-16, pg. 7, line 28. The first hair foil sheet is applied to a person's hair. Pg. 7, line 23, pg. 8, lines 29-30.

The invention further comprises that the first hair foil sheet is dispensed with one hand and used immediately without further preparation. pg. 8, lines 6-7.

**VI. Grounds of rejection to be reviewed on appeal**

Whether Claims 9 and 10 are unpatentable under 35 USC 103 over Conway, 2,087,181.

Whether Claims 9 and 10 are unpatentable under 35 USC 103 over Leto, 4,185,753.

## **VII. Argument**

### **Claims 9 and 10 are unpatentable under 35 USC 103 over Conway, 2,087,181.**

Conway relates to a dispensing container for housing interlock sheets in package form. The device is a portable device which may be clamped to a hair curler. Conway requires a spring to bear against a package of sheets. In fact, Leto, describes the container of Conway as requiring spring means to force available sheets toward their respective discharge slots or openings. In Conway, the sheets must be loaded in the dispenser at the end opposite the discharge slot. Hair treating solutions used in modern treatments attach many required material. The clamps of Conway attached to a roller which is in contact with such solutions, are subject to wear and corrosion after repeated use.

Product Club began selling the pop-up foil described in the above patent application in the fourth quarter of 2001. Prior to this time, Product Club had been selling roll foil and pre-cut foil to the Beauty Industry. Roll foil is defined as foil that is on a roll that can be cut when needed and used for hair coloring applications. Pre-cut foil is defined as foil that is stacked, one sheet on top of another, much like a deck of playing cards, which can then be used for hair coloring applications. (Declaration, para. 2).

The differences between the roll foil, pre-cut foil and pop-up foil all relate to the method in which they are dispensed, and then applied to the hair, which is directly related to the claimed invention. (Declaration, para. 3).



The claims of the present invention which relate to the pop-up foil relate to removing a first sheet of hair foil from the pop-up dispenser, the first sheet of hair foil ranging in width from 3.5-6". The sheet of hair foil has a lead portion and a trail portion. The lead portion of the sheet of hair foil extends through a dispensing orifice through an elevation above the dispensing unit. The trailing portion of the first hair foil sheet overlaps with a lead portion of the next hair foil sheet to be dispensed. By withdrawing the first sheet of hair foil, the next hair foil sheet is pulled through the orifice of the dispenser, and is awaiting further use. The first hair foil sheet can then be applied directly to a person's hair. (Declaration, para. 4).

With the roll foil, the foil must be cut to the appropriate length and then placed into a person's hair for hair coloring applications. This process requires multiple steps that are not required with the pop-up foil method. (Declaration, para. 5).

With the pre-cut foil, the first sheet, and each subsequent sheet of foil, must be separated from the stack of foil before being applied to a person's hair. Therefore, the second sheet, and each subsequent sheet, is not ready for use. This process requires multiple steps that are not required with the pop-up foil method. (Declaration, para. 6).

Therefore, the method described in paragraph 4 above for Product Club's pop-up foil creates a convenient and time saving way of dispensing hair foil which has led to Product Club's success. (Declaration, para. 7).

From 2001 until today, the market share for Product Club's pop-up foil has gone from 0% in 2001 to almost 60% in 2005 of the foil being sold by Product Club to the Beauty Industry. Product Club's pop-up foil sales have almost tripled in size since 2002. The other foil products such as roll foil and pre-cut foil have not grown to the same extent. (Declaration, para. 8).

Since the only difference in the pre-cut foil, the roll foil and the pop-up foil is the method in which they are dispensed and placed in the hair, Product Club's pop-up foil market share and profitability must be directly linked to the method in which the pop-up foil is being dispensed and placed in the hair. (Declaration, para. 9).

**Claims 9 and 10 are unpatentable under 35 USC 103 over Leto, 4,185,753.**

Leto relates to end wraps. End wraps are made from lightweight paper and are used in a permanent process to curl the hair. The claims of the patent require a method of putting hair foil on a person's hair. Hair foil is used for a hair coloring procedure and not a permanent procedure, to distinctively different hair devices. The hair foil of the claims is 3.5 to 6" in width and when dispensed is approximately 11" long. This is significantly longer than an end wrap paper, having an average size of 3-4" in width and 3-4" long.

Further, the foil of the present application is significantly heavier than the paper described in Leto. For example, it is realistic to place a small light weight box of end wraps on your arm utilizing the device taught by Leto. A box of end

wraps weighs only a few ounces. The same box of foil weighs approximately 1.5 pounds. It would not be feasible for one skilled in the art of hair coloring to wear such a heavy box of foil on their wrists/arms while performing a hair color service.

A ready to use piece of foil that is approximately 5" width by 11" long is presently being sold in a box containing 500 sheets. Such a box has overall dimensions of approximately 5.5" wide, 5.75" long and 4" tall. It is impractical to place a box of this size and this weight on the wrist of one skilled in the art of hair coloring without seriously compromising the final result or without risking injury to the colorist or their client.

Leto relates to a device for dispensing flexible sheets of absorbent paper or other fibrous material, which are end wraps. This is very different from the foil of the present invention.

Since the claims require consisting of language, and the prior art references require the spring and the weight of the paper, the claims cannot be obvious over the prior art.

Product Club began selling the pop-up foil described in the above patent application in the fourth quarter of 2001. Prior to this time, Product Club had been selling roll foil and pre-cut foil to the Beauty Industry. Roll foil is defined as foil that is on a roll that can be cut when needed and used for hair coloring applications. Pre-cut foil is defined as foil that is stacked, one sheet on top of

another, much like a deck of playing cards, which can then be used for hair coloring applications. (Declaration, para. 2).

The differences between the roll foil, pre-cut foil and pop-up foil all relate to the method in which they are dispensed, and then applied to the hair, which is directly related to the claimed invention. (Declaration, para. 3).

The claims of the present invention which relate to the pop-up foil relate to removing a first sheet of hair foil from the pop-up dispenser, the first sheet of hair foil ranging in width from 3.5-6". The sheet of hair foil has a lead portion and a trail portion. The lead portion of the sheet of hair foil extends through a dispensing orifice through an elevation above the dispensing unit. The trailing portion of the first hair foil sheet overlaps with a lead portion of the next hair foil sheet to be dispensed. By withdrawing the first sheet of hair foil, the next hair foil sheet is pulled through the orifice of the dispenser, and is awaiting further use. The first hair foil sheet can then be applied directly to a person's hair. (Declaration, para. 4).

With the roll foil, the foil must be cut to the appropriate length and then placed into a person's hair for hair coloring applications. This process requires multiple steps that are not required with the pop-up foil method. (Declaration, para. 5).

With the pre-cut foil, the first sheet, and each subsequent sheet of foil, must be separated from the stack of foil before being applied to a person's hair. Therefore, the second sheet, and each subsequent sheet, is not ready for use.

This process requires multiple steps that are not required with the pop-up foil method. (Declaration, para. 6).

Therefore, the method described in paragraph 4 above for Product Club's pop-up foil creates a convenient and time saving way of dispensing hair foil which has led to Product Club's success. (Declaration, para. 7).


From 2001 until today, the market share for Product Club's pop-up foil has gone from 0% in 2001 to almost 60% in 2005 of the foil being sold by Product Club to the Beauty Industry. Product Club's pop-up foil sales have almost tripled in size since 2002. The other foil products such as roll foil and pre-cut foil have not grown to the same extent. (Declaration, para. 8).

Since the only difference in the pre-cut foil, the roll foil and the pop-up foil is the method in which they are dispensed and placed in the hair, Product Club's pop-up foil market share and profitability must be directly linked to the method in which the pop-up foil is being dispensed and placed in the hair. (Declaration, para. 9).

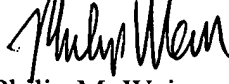
Reversal of the Examiner and allowance of all the claims are accordingly respectfully requested.

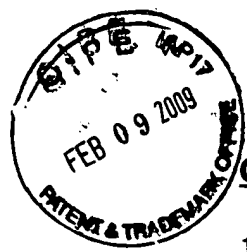
A copy of the Brief and our check for \$270.00 are enclosed herewith.

"EXPRESS MAIL" Mailing Label No. EM 329982158 US  
Date of Deposit: February 9, 2009  
I hereby certify that this paper (and any document(s) attached herewith  
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date indicated above and is addressed to the Commissioner  
for Patents, P.O. Box 1450, Alexandria, VA 22313 on  
February 9, 2009

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## **CLAIMS APPENDIX**

1. Cancelled

2. Cancelled

3. Cancelled

4. Cancelled

5. Cancelled

6. Cancelled

7. Cancelled

8. Cancelled

9. A method of putting hair foil in a person's hair consisting of:

removing a first sheet of hair foil from a pop-up dispenser;

said first sheet of hair foil ranging in width from about 3.5 to 6 inches;

said sheet of hair foil having a lead portion and a trailing portion;

said lead portion of said sheet of hair foil extending through a dispensing orifice  
to an elevation above that of said dispensing unit;

said trailing portion of said first hair foil sheet overlapping with a lead portion of  
a next hair foil sheet to be dispensed;

pulling said next hair foil sheet through said orifice of said dispenser by  
withdrawing said first sheet of hair foil;

said next hair foil sheet ranging in width from about 3.5 to 6 inches; and

applying said first hair foil sheet to a person's hair.

10. The method of claim 9 wherein said first hair foil sheet can be dispensed with one hand and used immediately without further preparation.



## **EVIDENCE APPENDIX**

See Second Declaration dated May 30, 2006, attached hereto as Exhibit 1.

**RELATED PROCEEDING APPENDIX**

None



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Eric Polesuk

Serial No.: 10/072,528

Filing Date: February 8, 2002

For: READY TO USE  
HAIRCOLORING FOIL

Examiner: S. Willatt

Dated: May 30, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

**SECOND DECLARATION**

1. I, Eric Polesuk, President and CEO of Product Club Corp, and inventor of the pending patent application Serial No. 10/072,528, do hereby declare the following:
2. Product Club began selling the pop-up foil described in the above patent application in the fourth quarter of 2001. Prior to this time, Product Club had been selling roll foil and pre-cut foil to the Beauty Industry. Roll foil is defined as foil that is on a roll that can be cut when needed and used for hair coloring applications. Pre-cut foil is defined as foil that is stacked, one sheet on top of another, much like a deck of playing cards, which can then be used for haircoloring applications.
3. The differences between the roll foil, pre-cut foil and pop-up foil all relate to the method in which they are dispensed, and then applied to the hair, which is directly related to the claimed invention.

4. The claims of the present invention which relate to the pop-up foil relate to removing a first sheet of hair foil from the pop-up dispenser, the first sheet of hair foil ranging in width from 3.5-6". The sheet of hair foil has a lead portion and a trail portion. The lead portion of the sheet of hair foil extends through a dispensing orifice through an elevation above the dispensing unit. The trailing portion of the first hair foil sheet overlaps with a lead portion of the next hair foil sheet to be dispensed. By withdrawing the first sheet of hair foil, the next hair foil sheet is pulled through the orifice of the dispenser, and is awaiting further use. The first hair foil sheet can then be applied directly to a person's hair.
5. With the roll foil, the foil must be cut to the appropriate length and then placed into a person's hair for haircoloring applications. This process requires multiple steps that are not required with the pop-up foil method.
6. With the pre-cut foil, the first sheet, and each subsequent sheet of foil, must be separated from the stack of foil before being applied to a person's hair. Therefore, the second sheet, and each subsequent sheet, is not ready for use. This process requires multiple steps that are not required with the pop-up foil method.
7. Therefore, the method described in paragraph 4 above for Product Club's pop-up foil creates a convenient and time saving way of dispensing hair foil which has led to Product Club's success.
8. From 2001 until today, the market share for Product Club's pop-up foil has gone from 0% in 2001 to almost 60% in 2005 of the foil being sold by Product Club to the Beauty Industry. Product Club's pop-up foil sales have almost tripled in size since 2002. The other foil products such as roll foil and pre-cut foil have not grown to the same extent.

9. Since the only difference in the pre-cut foil, the roll foil and the pop-up foil is the method in which they are dispensed and placed in the hair, Product Club's pop-up foil market share and profitability must be directly linked to the method in which the pop-up foil is being dispensed and placed in the hair.

10. All of the statements made herein are of my own knowledge and are true, these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application and any patent issuing thereon, or any patent to which this verified statement is applied.

May 30, 2006  
Date of Signature

By:   
Eric Polesuk